

**REMARKS**

Election of Species

The Examiner has identified four species into which the application has been divided which were set forth as follows:

Species I - Figures 1-8

Species II - Figures 9-11

Species III - Figures 12 and 13

Species IV - Figures 14-18

Applicant has elected Species I, with traverse, and it was stated that the Examiner would prosecute Species I.

Claims 8, 12, 16, 19, and 28-32 were withdrawn from consideration as directed to non-elected species, cited 37 CFR 1.142. It is noted that, although dependent upon claim 14, claim 16 actually reads on Figs. 9-11 (Species II).

Claim 25 is dependent upon claim 16, and so it also reads on Species II and has been shown above as withdrawn.

Claim Rejections - 35 U.S.C. §102

Claims 1-3, 5, and 33-44 and 24 were rejected under 35 U.S.C. 102(b) as anticipated by any of D'Eath (5,046,740); Anderson et al. (5,344,151); Guthrie et al. (5,700,207); or Baker et al. (5,716,290). In addition, claims 1, 3, and 33-34 were rejected under 35 U.S.C. 102(b) as being anticipated by Paquette (5,308,069).

Claim 1, which is an independent claim from which claims 2, 3, 5, and 24 depend, has been extensively amended and is now believed to distinguish over the above references.

With respect to D'Eath, claim 1 recites, "an elongated weight member secured to said support and centered thereon, said weight member . . . extending generally parallel to said striking face and being unsupported at its ends". While D'Eath might be considered to have a weight member (36, 38 etc.) secured to a support 10, the weight members do not constitute "an elongated weight member" centered on the support "extending generally parallel to said striking face and being unsupported at its ends", as now claimed. Claim 1 clearly defines over D'Eath.

Anderson et al. shows a tubular weight receptacle 18 which extends perpendicular to striking face 22 and which might be considered a support member. The weight member (any of weights 17) is not supported "generally parallel to said striking face" and "unsupported at its ends" as recited. Further, the triangular webs 14 and 26 would make this club very stiff, which would "teach away" from applicant's invention. Thus, it is believed that Anderson et al. does not anticipate claim 1.

Guthrie et al. teaches a golf putter which is formed of a short section of railroad rail. The striking face is formed of the base, which would normally sit on crossties of the track, and the rail itself forms a weight supported by a section of the web between the base and the rail. Such soleplate as there is is at the lower edge of the striking face and extends along the lower edge of the club to the weight member. As amended, claim 1

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recites that the weight member is "supported substantially above the level of said soleplate". In applicant's Fig. 3, the weight member is shown to be supported as claimed. This recitation does not read on Guthrie et al. where the weight member 10 is clearly supported at the same level as the soleplate, so claim 1 is believed to define over Guthrie et al.

The Baker et al. patent shows a putter that is apparently balanced on opposite sides of a hole or port 12, which receives the shaft. The front face 10a has secured to it a resilient member 14, which is of a polyurethane elastomer having an arcuate face 14a alleged to impart a top spin to a golf ball.

Other than the statement that recess 12 is coincident with the center of gravity of the clubhead, no written description is given of the weight shown on the backside of recess 12. We do not even have a side view of the entire clubhead, so we cannot know exactly the shape of the weight. From Figs. 2 and 3, it appears that the bottom of the club or soleplate is not generally horizontal but somewhat V-shaped. The bottom of the rearwardly extending support part containing recess 12 apparently is at the same level or height as the rest of the clubhead. This would indicate that the weight member of Baker et al. is clearly not "supported substantially above the level of said soleplate", as recited in claim 1. Thus, claim 1, as amended, is not anticipated by Baker et al.

From the foregoing, it is believed apparent that claim 1, as amended, clearly defines over the above references and is properly allowable. Dependent claims 2, 3, 5, and 24 are believed allowable for the same reasons.

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Claim 33 is an independent claim that has been amended somewhat similarly to claim 1 and distinguishes over D'Eath in reciting "a support vertically spaced from said soleplate". D'Eath's support 10 is clearly aligned with the bottom of his soleplate. Nor does D'Eath show "an elongated weight member", which is "unsupported at its ends", as now claimed.

Anderson et al. is distinguishable from claim 1, as amended, on essentially the same basis as D'Eath, the above quoted recitations not being readable on Anderson et al.

Guthrie is distinguishable from claim 1 in that his "support" is clearly aligned with the bottom of his soleplate, so is not "vertically spaced from said soleplate", as now recited.

The Baker et al. disclosure, discussed above, also fails to show "a support vertically spaced from said soleplate", as recited in claim 33. In Baker et al., the "support" would have to be read on the part of the clubhead, including port 12, which is not "vertically spaced" from the soleplate.

Claims 1, 3, and 33-34 were rejected under 35 U.S.C. 102(b) as being anticipated by Paquette (5,308,069), the Examiner stating:

"Paquette discloses a putter with legs 32 and 34 support member for the weight bar 28."

Claim 1, as amended, recites "a support extending perpendicularly with respect to the center of the striking face". Legs 32 or 34 do not constitute a support extending

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from the center of the striking face. Nor is weight 28 centered on such a support as claimed and the weight is clearly not "unsupported at its ends". Claim 1 is, therefore, believed to be allowable over Paquette.

Claim 3, being dependent upon claim 1, is also believed allowable over Paquette.

Claim 33, as amended, has recitations very similar to those discussed above with respect to claim 1. Paquette's support(s) do not extend rearwardly from the center of the striking face nor is his weight member "unsupported at its ends" as now claimed. If one reads the "support" on legs 32, 34, collectively, then the "elongated weight member" is not attached "at its center" to the support "such that the weight member is evenly balanced on opposite sides of its attachment to said support member".

Claim 33 is believed to be not anticipated by Paquette.

Claims 34 and 35 have been cancelled.

#### Claim Rejections - 35 U.S.C. 103

Claims 2, 4-7, 9-11, 13-15, 17, 18, 20-27, and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paquette '069. Of this group, claims 14, 20 and 33 are independent claims.

Claim 14 has been amended to recite "a generally horizontal soleplate" and "a support spaced from said soleplate". The claim further recites that the support extends perpendicularly from the rear of the striking face and is "centered thereon". The "elongated weight member" is defined as "secured to said support and centered

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thereon", and also that "said weight member . . . (is) unsupported at its ends", as discussed above regarding claim 33. Paquette's weight member is clearly not "centered" on its supports nor is it "unsupported at its ends". Claim 14 is believed to clearly define over Paquette.

Claim 20 has also been extensively amended. It now recites, "a single support shaft . . . centered on the rear side of said striking face portion" and further recites, "an elongated weight member secured to said support shaft and centered thereon . . . and unsupported at its ends". Paquette's weight 30 is not supported on a single support shaft and is supported at its ends, not unsupported. It is believed that claim 20, as amended, clearly defines over Paquette.

Claims 2, 4-7, 9-11, and 24 are all dependent upon claim 1, which has been substantially amended and distinguished over Paquette above. All of these dependent claims include the limitations of claim 1. Since applicant has distinguished amended claim 1 over Paquette above, it is believed that all of claims 2, 4-7, 9-11, and 24 also distinguish over this reference.

While the Examiner has chosen to regard the limitation of claim 2 of the "support and weight member as generally T-shaped" as "an obvious variation of design choice", the fact remains that Paquette does not show such structure. Paquette's weight bar 28, being supported at its ends by legs 32 and 34, is very stiff, which teaches away from applicant's invention. The fact that applicant's weight 26 is supported at its center and is unsupported at its ends is a key element in the invention.

As to claims 5 and 27, it would appear that the Examiner's statement,

"It would be obvious to have the claimed support member  
with sufficient extension to facilitate the attachment of the  
elongated cylindrical weight"

does not deal with the language of the amended head claims. In view of the amendments to independent claims 1 and 20 discussed above, claims 5 and 27 are believed to be clearly allowable.

With respect to claims 6, 10, and 21, it is noted that claims 6 and 10 are dependent upon claim 1, and claim 21 is dependent upon claim 20. Both are believed clearly allowable for the reasons set forth above as to claims 1 and 20. The Examiner's statement as to the obviousness of changing the mass distribution is believed to come from hindsight. There is no suggestion in the art of any reason or benefit of making this change.

Regarding claims 7, 11, 18, and 22, it was stated, "Paquette shows recesses (46, 48) functionally equivalent to the bore, to accommodate the legs or support member". Claim 7 is dependent upon amended claim 1 and believed allowable for the same reasons set forth above as to claim 1. Claim 11 has been cancelled. See discussion as to claim 22 below.

Claims 17 and 18 are now dependent upon claim 14 and applicant believes they are allowable along with claim 14.

Claim 22 is dependent upon claim 20 and believed to be allowable along with

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claim 20. In addition, however, applicant would argue that there is a substantial functional difference between off-center recesses and a centered bore which leaves the full impact of the support member directed to the ball.

Claims 13 and 35 have been cancelled.

Claims 15 and 24 are dependent upon claims 14 and 20, respectively, both of which were discussed above. It is believed that claims 15 and 24 are allowable along with claims 14 and 20.

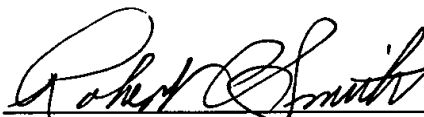
Claims 24 and 27 were amended to be consistent with amended claim 20.

Claim 23 has been cancelled.

Claim 25 is dependent upon claim 16 and is believed to belong with the non-elected group of claims.

It is believed that the remaining claims are in condition for allowance and favorable action is requested.

Respectfully submitted,



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